IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket: ATM-2129-1

Applicants : Roman FUCHS et al.

Serial No. : 09/898,167 Primary Examiner: Dhirajlal S. Nakarani

Filed : July 5, 2001 Art Unit: 1773

For : REFLECTOR WITH RESISTANT SURFACE

AMENDMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action of September 26, 2002, the following information and comments are submitted.

The Office Action stated that the reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

> It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Claims 1 to 15 have been rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above.

The Office Action stated that the nature of the defect(s) in the oath is set forth in the discussion above in this Office Action. The new (executed) reissue application is enclosed.

This rejection should be withdrawn.

The C.C.P.A., in In re Lange, 644 F.2d 856, stated:

> "Regarding appellant's use in the grandparent application of the term elements, we agree with the board that he had not expressly disclosed how the nonmetallic elements, fluorine, sulphur, or selenium, could be combined with the metallic elements, tungsten or molybdenum, to form electrodes capable of generating SF_6, SeF_6, or CF_3SF_5 gas. However, the disclosure in question must be read in light of the knowledge possessed by those skilled in the art, and that knowledge can be established by affidavits of fact composed by an expert, *In re Katzschmann*, 52 CCPA 1497, 347 F.2d 620, 146 USPQ 66 (1965), and by reference to patents and publications available to the public prior to appellant's filing date, *In re Eynde*, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973). ... We are satisfied that a person skilled in the art would readily consider prior uses of clathrate and other materials and, consequently, would substitute the broader terms, substances or compounds, for elements when reading the grandparent's specification. n10"

"n10. Appellant does not argue that a mere error in translation has occurred which should be correctable notwithstanding 35 USC 132. The German priority document upon which the grandparent application relied used the term 'stoffe.' When filing the grandparent application, appellant translated this term to mean elements. However, the PTO in translating the '594 Auslegeschrift which is the published version of the priority document relied on by appellant's grandparent application, translated 'stoffe' to mean substances." [Emphasis supplied]

[Pages 863 and 864]

The applicants had a search made to determine if Ex parte Bondiou et al., 132 U.S.P.Q. 356, (Bd. App. 1961), had been cited in any reported court or Board Of Appeals decisions other than in In re Oda et al., 170 USPQ 268, (C.C.P.A. 1971). No reported court or Board Of Appeals case was located that cited Ex parte Bondiou et al. The search also included looking for any reported court or Board Of Appeal decisions that had cited In re Oda et al. No case law was located that modified or reversed the pertinent holding of In re Oda et al.

The pertinent holding of In re Oda et al. was:

"On all the evidence, we conclude that one skilled in the art would appreciate not only the existence of error in the specification but what the error is. As a corollary, it follows that when the nature of this error is known it is also known how to correct it. We therefore disagree with the

board's first conclusion that the change of 'nitrious' to 'nitric' is 'new matter.'"

"We also think there is adequate evidence in the record to show that the error in saying 'nitrous' instead of 'nitric' was a translation error." [Emphasis supplied] [Page 272]

The amendment filed on July 2, 2002 has been objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. Applicants traverse this objection.

The Preliminary Amendment dated June 26, 2002 did not amend anything, but instead set out the basis for the amendment in the specification when the reissue application was filed. On this ground alone this objection is in error.

The Office Action stated that 35 U.S. C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The June 26, 2002 Preliminary Amendment did not amend anything in the reissue application. The reissue application, as filed, contained an amendment which was not new matter, as shown herein and earlier.

The Office Action stated that the added material which is not supported by the original disclosure is as follows; column 8, line 28, changing the phrase "protective layers are typically 1 nm thick" to the phrase – protective layers are typically from 1 nm thick – introduces new matter because the addition of the word "from" to the phrase allows the thickness range of the protective layers to

be open ended while the original phrase limits to "1 nm thick protective layers". Applicants traverse this statement because new matter is not involved.

Dependent Claim 12 in U.S. Patent No. 5,919,561 (Patent '591) states:

> "12. The reflector according to claim 1, wherein the reflective layer (c) is a multilayer system comprising a reflecting layer and deposited on that transparent protective layers with different refractive indices." [Emphasis supplied]

Dependent Claim 12 does not recite any thickness or thickness range for the transparent protective layer or layers. The thickness of the transparent protective layer in dependent claim 12 is "open ended" in both directions. This shows that the disclosure of Patent '591 teaches that the upper side of the thickness (range) of the transparent protective layer can be so-called "open ended". It would be obvious to one skilled in the art that the recitation "typically 1 nm thick" was an error and illogical when the transparent protective layer was "preferably from 40 to 200 nm thick". One skilled in the art would not typically use a one nm thickness when the preferred thickness is from 40 to 200 nm (the preferred thickness being at least 40 fold greater than the typical thickness). It is illogical and against the practice in the packaging/material/chemical fields and the patent filed to have the typical thickness being a single point value that is very for outside of the preferred range and does not cover the preferred range. The practice in the art is for the general/typical range to encompass the preferred range. One skilled in the art would readily ascertain the obvious error, and would readily see that the open endedness in dependent Claim 12 provided for the

correction of the error (and remove the illogic situation caused by error). The rule in In re Oda et al. is thereby followed and complied with by correcting the error to recite "typically more than 1 nm thick". The disclosure of Patent '591 directs the correction of the subject error caused by the translation error.

Dependent Claim 13 in Patent '591 states:

> "13. The reflector according to claim 1, wherein the reflective layer (c) is a multilayer system comprising a reflecting layer and deposited thereon transparent protective layers with different refractive indices, the reflectivelayer being 10 to 200 nm thick and <u>each of the transparent protective layers being 40 to 200 nm thick</u>."[Emphasis supplied]

This is the preferred thickness range. It is clearly illogical to one skilled in the art that the typical thickness (range) would not encompass the preferred thickness (range).

The pattern of the recitation of the thickness of the transparent protective layer in column 8 of Patent '591 also supports the amendment as not being new matter. Column 8, lines 28 and 29, recite "... are typically [?] 1 nm thick, preferably <u>from</u> 40 to 200 nm thick..." [Emphasis supplied] That sentence also evidences that its structure would be missing the word "from" the typical thickness recitation (which is in line with the open endedness of dependent Claim 12).

The pattern used by the other thickness ranges in Patent '561 have the preferred or advantageous thickness ranges within the span or scope of the general or typical thickness ranges – see column 2, lines 64 to 66, (reflector

bodies), column 3, lines 19 to 34, (pre-treatment layer), column 5, lines 50 to 59, (aluminum oxide layer), and column 9, lines 13 to 15, (oxide-containing bonding layer).

Roman Fuchs is one of the joint inventors in U.S. Patent No. 5,919,561 (the one for which the reissue application was filed). Column 1, lines 34 to 46, of Patent '561 discusses the disclosure of European Published Application No. 0495755 A1 (European '755). Roman Fuchs is also one of the joint inventors in European '755. The publication date of European '755 is in July 1992.

The discussion of European '755 in Patent '561 discloses objects having an aluminum surface, upon which is sequentially located a bonding layer (e.g., a ceramic layer), a light-reflecting layer (e.g., a metallic layer, e.g., aluminum), and "one or more transparent protective layers of metallic compounds".

European '755 is based upon Swiss Patent Application No. 68/91 (filed on January 1, 1991). U.S. Patent No. 5,403,657 (Patent '657), 5,527,572 and 5,663,001 each claim the priority of Swiss Patent Application No. 68/91 and each has the effective U.S. filing date of December 23, 1991. The first two mentioned U.S. patents have publication dates before applicants' U.S. filing and Swiss priority filing dates. Roman Fuchs is one of the joint inventors in all three of such U.S. patents.

All three of such U.S. patents have the same disclosure as that of European '755 of objects having an aluminum surface, upon which is sequentially located an optional adhesive layer (e.g., a metallic layer), and at least one transparent protective layer (e.g., of various metallic compounds). The

following discussion of Patents '657 equally applies to the other two of such U.S. patents.

Column 3, lines 44 and 45 , of Patent '657 states:

"The individual layers are typically 1 to 200 nm, preferably 1 to 100 nm thick."

One skilled in the art and joint inventor Roman Fuchs use typical thickness ranges that span or encompass preferred thickness ranges. It is illogical otherwise and would indicate an obvious error to one skilled in the art.

A copy of U.S. Patent Nos. 5,403,657, 5,527,572 and 5,663,001 and European Published Patent Application No. 0495755 A1 is enclosed. The knowledge possessed by one skilled in the art can be established by reference to patents available to the public before applicants' filing date – see In re Lange (that involved a new matter issue).

The Office Action stated that applicants are required to cancel the new matter in the reply to this Office Action. Applicants traverse this requirement and have shown herein that new matter is not involved.

This objection should be withdrawn.

Claims 1 to 15 have been rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. Applicants traverse this rejection and have shown herein that new matter is not involved.

The Office Action stated that the added material which is not supported by prior patent is as follows:

Column 8, lines 28, changing the phrase "protective layers are typically 1 mn thick" to the phrase – protective layers are typically from 1 nm thick – introduces new matter because the addition of the word "from" to the phrase allows the thickness range of the protective layers to be open ended while the original phrase limits to "1 nm thick protective layers".

Applicants traverse this statement. The added material is supported by the disclosure of Patent '591 and the knowledge of one skilled in the art. In re Oda et al. and In re Lange support applicants' position that new matter is not involved. The Examiner's position is clearly in error and unsupported by the evidence.

The applicants' discussion and evidence above under the objection are incorporated here (so as not to be redundant).

This rejection should be withdrawn.

The Office Action stated: that, applicants' arguments, filed on July 2, 2002, have been fully considered but they are not persuasive. Applicants traverse this statement for the reasons and evidence presented herein.

The Office Action stated: that, regarding insertion of the word "from" at column 8, applicants state that it is a translation error because the translator did not translate the German work "von" in the German language priority Swiss applications so the English translation comprising the U.S. Application underlying U.S. Patent No. 5,591,561 left out the English word "from"; and that, in support for correction, applicants have provided certified translation of priority documents and cited case law In re Oda et al., 170 USPQ 268, (C.C.P.A. 1971). Applicants traverse this statement as being incorrect in that it is incomplete. The

Preliminary Amendment presented analysis and evidence that one skilled in the art would appreciate that the error was present, what the error was and how to correct it – this meets the requirements of In re Oda et al. so the amendment did not involve new matter. Applicants have herein presented further reasons and evidence to show that new matter is not involved.

The Office Action stated: that these arguments are unpersuasive because as per MPEP 2163.07 (section II-Obvious Errors), which states "[w]where a non-English foreign priority document under 35 U.S.C. 119 is of record in the application file, applicants may not rely on the disclosure of that document to support correction of an error in the pending application Ex parte Boudiou, 132 USPQ 356 (Bd. App. 1961); and that this prohibition applies regardless of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is common to two or more applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. Applicants traverse this statement because it ignores that applicants have complied with the requirements of In re Oda et al. and In re Lange to show by reasons and evidence that new matter is not involved. Furthermore, under the circumstances of the case at bar the Board decision is not controlling or even apropos. The later decisions of In re Oda et al. and In re Lange of the C.C.P.A. are the controlling and apropos decisions.

The Examiner has misanalyzed the In re Oda et al. decision and incorrectly attempted to limit in re Oda et al. to its particular set of facts. In re

Oda et al. expressly sets out the broad principals and procedures for determining if any particular amendment does or does not constitute new matter. Specifically, In re Oda et al. states:

> "On all the evidence, we conclude that one skilled in the art would appreciate not only the existence of error in the specification but what the error is. As a corollary, it follows that it is also known how to correct it. We therefore disagree with the board's first conclusion that the change of 'nitrous' to 'nitric' is 'new matter.'"
>
> "We also think there is adequate evidence in the record to show that the error in saying 'nitrous' instead of 'nitric' was a translation error." [Emphasis supplied] [Page 272]

In re Oda et al. dealt with a translation error and set out the principles and procedures of how to determine whether or not new matter was present. The Examiner has not followed the analysis, principles, etc., required by In re Oda et al. (and In re Lange). The present objection and rejection are defective. For example, the Examiner did not deal with or mention the following from the Preliminary Amendment:

> "The error was that the translator left the word 'from' out of the phrase 'are typically from 1 nm thick, preferably from 40 to 200 nm thick' (in German). One skilled in the art would know that an error was present in the phrase 'are typically 1 nm thick, preferably from 40 to 200 nm thick,'. That is, it appears to be an error to say that the (each) transparent protective layer typically has a thickness of 1 nm when the preferred

thickness range is from 40 to 200 nm. Note that Claim 12 does not contain any thickness value or range for any of the transparent protective layers of reflective layer (c). [Emphasis supplied] [Page 1 and 2]

The Office Action stated: that, additionally applicants' reliance on In re Oda et al. does not appear to be presuasive because the fact scenario is Oda was vastly different; that, in the opinion of Oda, the court found that not only was there a translation error, but also evidence in the application as originally filed that the term "nitrous acid" was originally mistyped based on the following: (a) the specific gravity disclosed in the original application; (b) the reaction disclosed in the original application; (c) the fact that nitrous acid is undesirable for the nitration of amines; and (d) nitrous acid would not function in the process disclosed in Oda; and that the present Reissue does not contain such a fact situation based on the application as originally filed. Applicants traverse this statement. The Examiner has erroneously, without any justification, attempted to restrict the application of In Re Oda et al. to the specific or type of fact situation involved in In re Oda et al. As applicants have shown above, In re Oda et al. is not so restricted. In re Oda et al. sets out broad principles and procedures to be used in determining whether or not new matter is involved. In re Oda et al. is not limited to its specific facts or factual type of situation. Furthermore, In re Lange stated that one skilled in the art and such person's knowledge (as shown, for example, by prior patents) had to considered and examined in determining if new matter was or was not present.

Applicants also question whether the Section 251 rejection is proper – see M.P.E.P. 2163.06 (Section 112).

The Examiner's attention is also drawn to the following:

M.P.E.P. 2163 states;

> "While there is no *in haec verba* requirement, newly added claim limitations much be supported in the specification through express, implicit, or inherent disclosure. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971)." [Emphasis Supplied] [Page 2100-157]

This summarization of In re Oda et al. is incorrect because on re Oda et al. states:

"As a corollary, it follows that when the nature of this error is known it is also known how to correct it." [Emphasis supplied] [Page 272]

M.P.E.P. 2163.05 states:

> "With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure." [Page 2100-171]

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

Virgil H. Marsh

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Virgil H. Marsh
Reg. No. 23,083

Fisher, Christen & Sabol
1725 K Street, N.W.
Suite 1108
Washington, D.C. 20006
Tel.: (202) 659-2000
Fax: (202) 659-2015